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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,601	03/23/2001	James T. Lynn	GE04347	3710

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Motorola, Inc.
Law Department
1303 East Algonquin Road
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EXAMINER
DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
2437	

NOTIFICATION DATE	DELIVERY MODE
05/24/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.US@motorola.com

	Application No.	Applicant(s)
Office Action Summary	09/814,601	LYNN ET AL.
	Examiner	Art Unit	
	Zachary A. Davis	2437	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 March 2010</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-5</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114 was filed in this

application after a decision by the Board of Patent Appeals and Interferences, but

before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or

the commencement of a civil action. Since this application is eligible for continued

examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been

timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution

in this application has been reopened pursuant to 37 CFR 1.114. Applicant's

submission filed on 23 March 2010 has been entered.

2.   By the above submission, Claim 1 has been amended. No claims have been

added or canceled. Claims 1-5 are currently pending in the present application.

Response to Arguments

3.   Applicant's arguments with respect to claims 1-5 have been considered but are

moot in view of the new ground(s) of rejection.

4.   It is noted that Applicant's arguments fail to comply with 37 CFR 1.111(b)

because they amount to a general allegation that the claims define a patentable

invention without specifically pointing out how the language of the claims patentably

distinguishes them from the references.

Specification

5.   The specification is objected to as failing to provide proper antecedent basis for

the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: Claim 1 has been amended to recite that the "network

appliance is determined to be authorized [to] receive said authorized components".

There does not appear to be proper antecedent basis for this limitation in the

specification. There appears to be no mention of the appliance being authorized, nor

does there appear to be any mention of performing any such determination. For further

detail, see below regarding the rejection under 35 U.S.C. 112, first paragraph, for failure

to comply with the written description requirement.

Claim Objections

6.   Claim 1 is objected to because of the following informalities:

        Claim 1 recites "said network appliance is determined to be authorized receive

said authorized components" in lines 13-14. It appears that "to" should be inserted after

"authorized".

        Appropriate correction is required.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8.   Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

        Independent Claim 1 has been amended to include the limitation that "said network appliance is determined to be authorized [to] receive said authorized components". There does not appear to be sufficient written description support for this limitation in the specification. Although Applicant alleges that support is to be found at page 3, lines 3-30 of the present specification (see page 3 of the present response), neither this portion nor the remainder of the specification appears to describe determination of whether a network appliance is authorized to receive the authorized components. The specification does describe the components as authorized (see, for example, page 2, lines 27-30 of the present specification); however, there does not appear to be any description of the appliance being authorized or any determination thereof. The background of the specification does mention authorized end users (page

1, lines 24-29), but this is only with respect to a problem or need in the prior art, and

there is, again, no description of any determination of authorization of a network

appliance.

Claims 2-5 are rejected due to their dependence on rejected Claim 1.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Slivka et al, US Patent 6049671, in view of Cheng et al, US Patent 6151643.

In reference to Claim 1, Slivka discloses a method for securely distributing a

component including signing a configuration file (the cabinet in the distribution file of

column 16, line 55-column 17, line 1) including a load table which defines a plurality of

authorized components for a network appliance (the summary of available software of

column 8, lines 34-37; see also column 5, lines 55-65; column 6, lines 39-49; column 8,

lines 43-56, where the user authorizes downloading some or all of the available

software components; see also column 13, lines 37-60 where the cabinet is generated

from the authorized and requested software components), executing a secure kernel for

checking the authenticity of the configuration file (column 17, lines 58-63) and for

establishing communication with a network host (column 6, lines 12-18), verifying the
authenticity of the configuration file (column 17, lines 58-63), reading the load table, and
loading authorized components defined in the load table onto a network device (column
8, line 65-column 9, line 2; column 18, lines 44-48). However, Slivka does not explicitly
disclose that the network appliance is determined to be authorized to receive the
components.

     Cheng discloses a method for updating software that includes both a user/client
authorizing which components are to be downloaded (column 8, lines 21-31) and the
user/client being determined to be authorized to receive the components (column 7,
lines 40-45; see also column 16, lines 38-67). Therefore, it would have been obvious to
one of ordinary skill in the art at the time the invention was made to modify the method
of Slivka to include authorization of the network appliance, in order to only allow
authorized users to download software updates (see Cheng, column 7, lines 40-45).

     In reference to Claim 2, Slivka and Cheng further disclose that the loaded
available software can be an operating system (the database of available software of
Slivka, column 7, lines 49-57, can include operating system components).

     In reference to Claim 3, Slivka and Cheng further disclose loading a software
application (Slivka, column 7, lines 49-64; column 8, line 65-column 9, line 2).

     In reference to Claim 4, Slivka and Cheng further disclose that the loaded
available software can be services (the database of available software of Slivka, column
7, lines 49-57 can include patches, fixes, and wizards).

In reference to Claim 5, Slivka and Cheng further disclose generating an updated configuration file (Slivka, column 8, lines 27-33; see also column 5, lines 55-65; column 6, lines 39-49; column 8, lines 43-56; and column 13, lines 37-60, where the list of available software can be updated and new cabinet files can be generated based on the updated list of software authorized for installation by the user), signing the updated configuration file (Slivka, column 16, lines 65-67), transmitting the signed configuration file (Slivka, column 8, lines 34-37; column 17, lines 51-57), verifying the authenticity of the updated configuration file (Slivka, column 17, lines 58-63), and reading the updated configuration file (Slivka, column 8, lines 34-46; column 8, line 65-column 9, line 7; column 18, lines 44-48).

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

    a.   Shostack et al, US Patent 6298445, discloses a system in which authorized local users can install software updates.

    b.   Wiehler, US Patent 6850915, discloses a method for distribution of software that includes providing certificates to users in order to authorize use of the software.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571)272-3870. The examiner can normally be reached on weekdays 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Zachary A Davis/
Primary Examiner, Art Unit 2437